

REMARKS

Claims 1-19 are pending in the application, and stand rejected. Claims 20-58 have been canceled from the application. Claims 40-58 are canceled herein as being drawn to a non-elected invention, and may be separately pursued in one or more divisional applications.

The paragraph beginning on page 6, line 8 of the application has been amended to include disclosure taken from U.S. Pat. No. 4,617,374, which was incorporated by reference in the original application at page 6, lines 8-10 of the application as filed. The added disclosure includes an alternative formula structure, support for which can be in column 2 lines 48-55 of the '374 patent, and additional written disclosure found at column 2, lines 29-32 of the '374 patent. Applicants respectfully submit that the newly added disclosure contains no new matter, and respectfully request entry.

Claim 1 is amended herein to add an omitted instance of the word "and" . Claim 2 is amended herein to provide an alternative formula structure, support for which can be found in U.S. Pat. No. 4,617,374, which was incorporated by reference in the original application at page 6, lines 8-10 of the application as filed. Claim 19 is amended herein to change the transition language from "wherein" to "further comprising." Claim 8 is amended herein to add language to clarify the process description of the claim, support for which is clear from the claim as originally filed. Applicants respectfully submit that the claim changes contain no new matter, and respectfully request entry and favorable consideration.

Obviousness-type double patenting

Claims 1-19 were provisionally rejected in the Office Action on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of copending application number 10/855,723. Applicants respectfully traverse the rejection. However, because the rejection is a provisional rejection, Applicants request that the rejection be held in abeyance until there is an indication of allowable subject matter.

Rejections under 35 U.S.C. § 112

Claims 1-19 were rejected in the Office Action under 35 U.S.C. § 112, second paragraph, as assertedly being indefinite. Applicants respectfully traverse the rejection. However, because claim 1 has been amended to add the word "and" and claim 19 amended to change the transition language, Applicants respectfully request that the rejection be withdrawn.

Claims 1-19 were asserted not to be commensurate in scope with an enabling disclosure, citing 35 U.S.C. § 112, first paragraph, it being suggested that examples of the "substituted" substituents of R³ were required to enable the terms "substituted alkyl" and "substituted alkoxy." Applicants respectfully submit that examples of these substituents are not required in order to enable the rejected claims, that the use of these terms does not render the claims indefinite, and that one skilled in the art could readily choose the appropriate substituents, and would readily comprehend the substituents encompassed by the use of these terms, as evidenced, for example, by their use in U.S. Pat. No. 4,617,374. Applicants respectfully submit that the claims fully comply with 35 U.S.C. §112, and respectfully request that the rejection be withdrawn.

Rejections under 35 U.S.C. § 103(a)

Claims 1-19 were rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over Pruett et al. U.S. 4,617,374 (Pruett '374), Pruett et al. U.S. 5,459,224 (Pruett '224), Carman et al. U.S. 6,001,952 (Carman '952), or Weaver et al. U.S. 6,787,589, each in view of Fujimori et al. (U.S. 6,703,474) and JP407258394A (JP '394). Applicants respectfully traverse the rejection and request reconsideration, there being no motivation in the references or in the art generally to combine the references in the way in which they have been combined.

Applicants note that each of the cited primary references discloses or suggests a polyester polymer containing a UV absorber made using a titanium catalyst.

For example, the Pruett '374 patent, in Examples 53 and 54, discloses the use of acetyl triisopropyl titanate in a polymerization process in which a UV-absorbing compound such as that used in the present application is incorporated, there being no mention that other catalysts could or might be used when incorporating such a UV absorber. Similarly, the Pruett '224 patent, at column 9, line 2, describes as a preferred catalyst system the use of Mn/Ti/Co/P, which is the only catalyst system disclosed or exemplified. Likewise, the Carman '952 patent, at col. 5, lines 54-57 suggests the use of titanium catalysts. Further, Weaver et al. also use titanium catalysts in each of the examples in which polymerizations are conducted.

Applicants further submit that neither of the cited secondary references would lead those skilled any closer to the claimed invention, because they do not relate to the use of the UV absorbers of the present invention, nor do they suggest that the catalysts and processes described may be used with the UV absorbers of the present invention.

Instead, Fujimori et al. explain, in col. 8, lines 47-52, that the polyesters described preferably contain "at least one metal element component selected from the group consisting of Groups IA and IIA of the periodic table, zinc, aluminum, gallium, germanium, titanium, zirconium, hafnium, manganese, iron and cobalt." Similarly, in column 11, lines 36-44, they explain that the polyester resins described are produced "in the presence of at least antimony compound and a phosphorus compound, preferably in the coexistence of the above mentioned metal compound, particularly the magnesium compound and/or the titanium compound." Each of the cited passages likewise suggests the use of titanium catalysts. In fact, Fujimori et al., in column 9, lines 34-35, suggests that the use of titanium is preferred. Fujimori et al. thus teaches away from the present invention in which titanium catalyst is avoided.

Similarly, the JP '394 reference lacks any reference to the UV stabilizers presently being claimed, nor is there any suggestion that the catalysts used might be suitable in combination with them.

In light of the foregoing, Applicants respectfully submit that the references have been improperly combined, and that the only motivation to combine the references in the way in which they have been combined is to be found in the present application, using impermissible hindsight. Applicants respectfully submit further that Fujimori et al.

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explicitly teach away from the present application, in teaching that the use of titanium catalyst is preferred. Applicants therefore respectfully submit that the rejection is overcome, and request that it be withdrawn.

In summary, Applicants believe the application to be in condition for allowance, and respectfully request that the rejections be withdrawn and the claims allowed.

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Respectfully submitted,

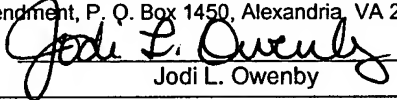


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Date